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09/393,463

09/10/1999

WILLIAM S. WOODS

899.009US1

2759

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02/11/2009

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EXAMINER

LAO, LUN S

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* WILLIAM WOODS

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Application No. 09/393,463  
Technology Center 2600

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Mailed: February 10, 2009

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Before TOI JOHNSON *Review Paralegal*  
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 9, 2008. A review of the application revealed that it is not ready for docketing as an appeal.

Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed November 1, 2007, under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the Final Rejection of record mailed November 15, 2006. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. See also Manual of Patent Examining Procedure (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Grounds of Rejection that has not been provided the required heading "New Grounds of Rejection" and which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth the following grounds rejection:

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6496581 to Finn et al (hereafter as Finn) in view of U.S. Patent No. 5,506,910 to Miller. [It is noted that Miller is now provided as directly corresponding evidence to support the prior common knowledge finding / Official Notice.];

4. Claims 8-23, 25, 28-29, 34, 36, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6496581 to Finn in view of U.S. Patent No. 5677987 to Seki et al (hereafter as Seki) and U.S. Patent No. 5,506,910 to Miller. [It is noted that Miller is now provided as directly corresponding evidence to support the prior common knowledge finding / Official Notice.]; and

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 20020044667 to Stott et al (hereafter as Stott) in view of Patent No. 5,506,910 to Miller. [It is noted that Miller is now provided as directly corresponding evidence to support the prior common knowledge finding / Official Notice.]

A review of the Final Rejection mailed November 15, 2006, reveals that Miller (US 5,506,910) was not discussed in any of the statements noted above under § 103(a). Correction of all Grounds of rejection for all claims is required.

### CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) vacate the Examiner's Answer mailed November 1, 2007;

2) generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;

Application No. 09/393,463

3) include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and

4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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